

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 15, 21, 26, 28, 30 and 35 have been amended and claims 4, 32, 33 and 36-39 have been canceled. Claims 40-53 have been added. The Applicant advises the Examiner that original claim 15 has been represented as claim 46.

Claims 1, 21, 28, and 30 were objected to because of informalities. The amendments to the claims have addressed the issues raised by the Examiner. Withdrawal of the objections of claims 1, 21, 28, and 30 is respectfully requested.

Claims 1, 4-12, 15, 17-20, 26 28 and 30-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D465,022 to Stansbury in view of U. S. Patent 4,842,095 to Rozek. Further claims 21, 22 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D465,022 to Stansbury in view of U. S. Patent 4,842,095 to Rozek and further in view of U. S. Patent 5,799,590 to Noguchi.

As set forth in the Office Action a non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper time wise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. Further, the Office Action provides that “[a] timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with the application.” Before requiring the filing of a terminal disclaimer in the instant application the Examiner is respectfully

requested to consider that the law is quite clear that there is a heavy burden of one seeking to show non-statutory double patenting in the context of utility versus design applications. Carmen Industries, Inc. v. Wahl et al., 220 USPQ 481, 487 (CAFC 1983). Further, the court provided that “[d]oubling patenting is rare in the context of utility versus design patents.” Id.

A non-statutory double patenting rejection is only proper if the prior patent claims are not patentability distinct from the application claims, and if the application claims are not patentability distinct from the prior patent claims. In re Goodman, 29 USPQ2d 2010, 2016 (CAFC 1993). The analysis is therefore predicated upon a two way test. Further, the Court of Appeals opinion in In re Goodman provides further guidance regarding the requirement for a terminal disclaimer. The opinion provides in the pertinent part:

[i]n *Braat*, the later-filed application containing claims to a patentable combination that included a subcombination which was the subject of an independent prior application. Although the later-filed application became a patent first, this court did not reduce the term of the earlier-filed, but later issued, patent. This court did not require a terminal disclaimer because Bratt’s application was held up not by the applicant, but by “the rate of progress of the application through the PTO, over which the applicant does not have complete control.”

In re Goodman, 29 USPQ2d 2010, 2016 (CAFC 1993).

The present application is a continuation application of application No. 09/941,524 (herein after FIRST APPLICATION) filed on August 29, 2001. During the prosecution of the FIRST APPLICATION a First Office Action rejecting all of the claims issued on June 24, 2002, a Response was filed December 24, 2003, and a Final Office Action issued on April 24, 2003. In contrast U.S. Patent No. D465,022 to Stansbury was filed on October 9, 2001 and issued on October 29, 2002. The ‘022 design Patent was filed after the FIRST APPLICATION and issued approximately four months after the issuance of the First Office Action on the FIRST APPLICATION. It is believed very fair and reasonable to conclude that the Applicant did not

hold up the progress of the FIRST APPLICATION through the Patent Office. More specifically, the present facts support that a terminal disclaimer should not be required to remove a non-statutory double patenting rejection. Withdrawal of the non-statutory double patenting rejections founded upon U.S. Patent No. D465,022 to Stansbury is respectfully requested.

Claims 1, 4-12, 30, 31, 34 and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 4,721,275 to Benton et al. in view of U. S. patent 1,887,283 to Brabson in view of U. S. Patent 1,230,836 to Ballenberg, and further in view of U. S. Patent 4,842,095 to Rozek. Claims 15, 17-20 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benton in view of Rozek and further in view of Brabson. Claims 21, 22 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,799,590 to Noguchi in view of Benton in view of Rozek and further in view of U.S. Patent 5,557,824 to Bushey. Claims 26, 27, 32 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benton in view of Brabson in view of Ballenberg in view of Rozek and further in view of Bushey. The Applicant respectfully traverses the §103 rejections.

It is well settled that a claim is unpatentable under 35 U.S.C. §103 “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. §103(a) (Supp. 2004). The seminal case directed to application of 35 U.S.C. §103 is *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459 (1966), from which four familiar factual inquiries have resulted. The first three are directed to prior art evaluation, and the last is directed to secondary considerations. See Manual of Patent Examining Procedure (MPEP) §2141. From these inquiries, the initial burden is on the Examiner to establish a *prima facie* case of obviousness. “First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

In evaluating claims under 35 U.S.C. §103 the courts have emphasized the statutory language "at the time the invention was made. For it is this phrase that guards against entry into the 'tempting but forbidden zone of hindsight . . .'" *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) *citing Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985). "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). In order to properly determine whether the invention is patentable under §103 the Examiners' analysis should be "determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains." *Id.* at 1457. In summary the Court of Appeals has instructed that "the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *Id.*

The suggestion/motivation to combine or modify under §103 needs to be specific. Where a "statement is of a type that gives only general guidance and is not specific as to the particular form of the claimed invention and how to achieve it ... [s]uch a suggestion may make an approach 'obvious to try' but it does not make the invention obvious." *Ex parte Obukowicz*, 27

USPQ2d 1063, 1065 (U.S. Pat. And Trademark Of. Bd. of Pat. App. & Interferences 1993)
(citations omitted).

In each of the §103 rejections United States patent No. 4,721,275 to Benton is utilized as the primary reference in rejecting the claims defining the furnace mount and/or a combination including the furnace mount. Upon review of the '275 reference it is noted that the text and drawings, teach and suggest a steady leveling device 10 as set forth in figures 1-4 and a second steady leveling device 10a as set forth in figure 5. The steady leveling device 10 includes a point 32 that "can penetrate through carpet, underlayment and dig into floor underneath (not shown) to stabilize the base 26 of the furniture 12." Col. 2, l. 3-6. It is believed fair to conclude that Benton '275 teaches to transfer the load of the furniture through point 32 to the floor in order to enhance stability for tall narrow pieces of furniture. In keeping with this concern about the stability of the tall narrow pieces of furniture the leveling device 10 is securely fixed to the furniture 12 by a plurality of screws 42 that pass through the vertical flange 16 and horizontal flange 18 of the L-shaped bracket 14. The screws 42 insure that the leveling device 10 is mechanically connected to and not easily separated from the furniture 12. Further, each of the screws 42 provides a mechanical pathway from within the furniture 12 to the leveling device 10. In the event of vibrations the screws 32 would transfer vibration between the furniture 12 and the leveling device 10.

With reference to figure 5 of the '275 reference, there is illustrated a cross sectional view of a modified steady leveling device 10a. The steady leveling device 10a includes a horizontal flange 18a of L-shaped bracket 14a. A mounting screw 54 passes through the horizontal flange 18a and secures the L-shaped bracket 14a to the horizontal surface 46 of the base 26 of the furniture 12. The modified steady leveling device 10a includes a rack member 64 and thin screw

72 that are manipulated to drive the mounting screw 54 into the base 26 of the furniture 12. The modification of Benton '275 to replace the screw fastening with adhesive fastening would destroy many of the reasons for Benton; how would the utilization of adhesive fastening be reconciled with the system taught and suggested for figure 5? The modification of Benton '275 by substituting an adhesive layer 26 from Rozek '095 appears to be founded in hindsight and does not consider the teaching of the '275 reference as a whole.

The Office Action sets forth that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main body member of Benton to include a second upstanding member perpendicular to the first upstanding member 16 because one would have been motivated to provide a means for firmly holding the supported object against movement as taught by Brabson '283 (pg. 2, lines 12-17)." The language cited by the Examiner refers to figure 4, which shows the arrangement of four plates 20 that are anchored into the floor by spurs or nodules 23. The anchoring of the four plates 20 will hold the article of furniture against movement. The Applicant does not follow how one reviewing the teaching of the '283 reference as a whole would be motivated to make the modification suggested in the Office Action. Further, the Patent Office is respectfully requested to reconcile the addition of a third screw fastener with the embodiment of Figs. 1-4 and a second screw fastener with the embodiment of Fig. 5. Withdrawal of the §103 rejection is respectfully requested.

The Office Action provides that the 37 CFR §1.132 declarations filed February 11, 2004 are insufficient to overcome the rejection of the claims. The Applicant respectfully disagrees with the conclusions drawn by the Examiner regarding the declaration of Tim Jacobson, Dave Cournoyer, Ron Jackson, Stephen Hutcherson, John Knipe, Gene Lee, Rick Elston, and Jeff Malone. More specifically, each of the declarations includes an attached series of drawings that

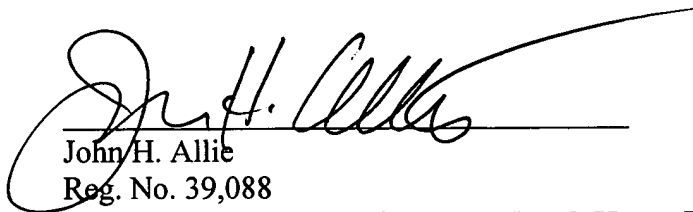
correspond to Figures 5-10 of the present patent application. The declarants are representing that the device they are discussing is as shown in the figures 5-10. Further, each of the declarants sets forth that they had never seen a light-weight furnace mounting block system of this type for elevating the furnace from the floor. As to benefits associated with the furnace mounting blocks the declarations provide many including: (1) a significantly enhanced installation; (2) improvement in the installer's work day by eliminating the need to carry heavy masonry blocks to the job site; (3) the ability to slide the furnace on the furnace mounting blocks; and time saving. Further, the declaration of Walter Key recites that the inventor, Mark A. Stansbury, has been in the business of selling and servicing heating and air conditioning systems for about 31 years. Mr. Stansbury's appreciation of the need for an improved system for mounting furnaces led to the furnace mounting blocks and systems in the present application.

The declaration of Walter Key (hereinafter KEY DECLARATION) specifically provides that the commercialized furnace mounting blocks are set forth in the advertisement in Exhibit B and by figures 5-10 of the present application. The KEY DECLARATION provides that the at least 50,000 furnace mounting blocks sold during the 2001 calendar year are of the type being shown in the advertisement in Exhibit B and set forth in the figures 5-10 of the present application. In terms of what "no extraordinary efforts" means the KEY DECLARATION provides that some manufacturers' representatives primarily called on wholesalers in the Midwest region of the United States. Further, the declaration provides that NSA (the assignee of the present application) spent less than \$12,000 on advertising for the furnace mounting blocks for the years 2001 and 2002 combined. Bramer Corporation, the exclusive licensee, posted the Furnace Mounting Block on their website and distributed a relatively small number of samples to various wholesalers within the United States. The Applicant respectfully requests

reconsideration of the evidence provided in the declarations and withdrawal of the §103 rejections.

In view of the foregoing it is submitted that this application which includes claims 1, 5-12, 15, 17-22, 26-31, 34, 35 and 40-53 is in condition for allowance. Consideration of an allowance at an early date is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John H. Allie", is written over a horizontal line. The signature is fluid and cursive, with a long, sweeping underline that extends to the right.

John H. Allie

Reg. No. 39,088

Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Center Tower
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456